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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,337	12/19/2001	Andrew Amadeo Munarriz	015719-0000 (B74051)	3463
20594	7590	10/06/2004	EXAMINER	
CHRISTOPHER J. ROURK AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P. P O BOX 688 DALLAS, TX 75313-0688			NGUYEN, MAIKHANH	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/025,337	Applicant(s) MUNARRIZ ET AL.	
	Examiner Maikhanh Nguyen	Art Unit 2176	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 December 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### ***DETAILED ACTION***

1. This action is responsive to the following communications: original application filed 12/19/2001.
2. Claims 1-68 are currently pending in this application. Claims 1, 16, 27, 48, 62-63, and 67 are independent claims.

### ***Priority***

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in UNITED KINGDOM on 12/19/2000. It is noted, however, that applicant has not filed a certified copy of the 0030944.3 application as required by 35 U.S.C. 119(b).

### ***Claim Objections***

4. Claims 2-15, 17- 47, 29-61, and 64-66 are objected to because of the following informalities:

- "a message signal" (claims 2-15) should read "the message signal" as it is referring to "a message signal" of claim 1;

- "a message system" (claims 17-26) should read "the message system" as it is referring to "a message system" of claim 16;

- “a server” (claims 28-47) should read “the server” as it is referring to “a server” of claim 27;
  - “a client” (claims 49-61) should read “the client” as it is referring to “a client” of claim 48;
  - “a method” (claims 64-66) should read “the method” as it is referring to “a method” of claim 64; and
  - “one message signals” (claim 27, lines 1-2) should read “one message signal”
- Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1- 68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following languages:

- *“a message signal, containing a message, or a machine readable stored message”*  
(claim 1);
- *“a message system arranged to transmit message using a message signal, containing a message, or to store a machine readable message”* (claim 16);

- *“a server arranged to receive or send one message signal, containing a message, or to store a machine readable message”* (claim 27);
  - *a server arranged to receive or send one message signal, containing a message, or to store a machine readable message”* (claim 48);
  - *“a computer program product for implementing a message system, a client, or a server, arranged to receive or send message signals, containing a message, or to store a machine readable message”* (claim 62);
  - *“a method of transferring message signals wherein the message signals comprises”* (claim 63); and
  - *“a method of storing a message wherein the stored message comprises”* (claim 67)
- render the claims indefinite because their meanings are not clear.

Dependent claims 2-15, 17-26, 28-47, 49-61, 64-66, and 68 are also rejected for fully incorporating the dependencies of their base claims.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-68 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-68 appear to be a data structure per se that is nonfunctional.

**Rejections - 35 USC § 102**

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or " (Emphasis added.)

Claims 1-28, 32, and 36-68 are rejected under 35 U.S.C. 102(e) as being anticipated by **Bose et al.** (U.S. Patent Application Publication 2002/0042830, filed 04/2001, priority 03/2000).

**As to independent claim 1**, Bose teaches a message signal, containing a message, or a machine readable stored message (*the abstract and para.003*), wherein the message comprises:

a format (*e.g., the XML format of the message; para.0092*) having delimiters that both mark regions containing values of fields and identify which fields those are (*e.g., para.0092 shows the fields of the XML message that are identified as, among other fields, CS010-Student1 field for receiving the response and Your teacher field for sending the response*).

**As to dependent claim 2**, Bose teaches the format is XML (*the XML format, para.0092*).

**As to dependent claim 3**, Bose teaches a field, in the format, indicating a recipient of the message (*e.g., the field CS101-Student1 for receiving the response from the teacher; para.0092*).

**As to dependent claim 4**, Bose teaches a field, in the format, indicating a sender of the message (*e.g., the field your teacher for sending the response to the student; para.0092*).

**As to dependent claim 5**, Bose teaches a field, in the format, indicating an address replies should be sent to (*e.g., JoePhipps@yahoo.com; para.0092*).

**As to dependent claim 6,** Bose teaches containing display layout information (*Fig.5 and the associated text*).

**As to dependent claim 7,** Bose teaches the message is an email message (*e.g., an email message; para.0119*).

**As to dependent claim 8,** it includes the same limitations as in claim 2 above, and is similarly rejected under the same rationale.

**As to dependent claim 9,** Bose teaches the message is an instant messaging message (*e.g., instant messaging; para.0022-0023*).

**As to dependent claim 10,** it includes the same limitation as in claim 2 above, and is similarly rejected under the same rationale.

**As to dependent claim 11,** Bose teaches a field, in the format, indicating an action to be carried out on the message (*e.g., para.0096 shows an XML representation of the message format having the plurality of fields, such as choice1, choice2, choice3 and choice4 for performing an action to be carried out on the message when one of the choices is selected.*)

**As to dependent claim 12,** it includes the same limitations as in claim 2 above, and is similarly rejected under the same rationale.

**As to dependent claim 13,** Bose teaches the field indicating the action to be carried out on the message indicates that it is to be sent (*e.g., para.0096-0098 shows that choice2 is selected by the user and the response will be sent to the poll initiator.*)

**As to dependent claim 14,** Bose teaches the field indicating the action to be carried out on the message indicates that it is to be stored (*e.g., store messages; para.0081*).



**As to dependent claim 15**, Bose teaches the field indicating the action to be carried out on the message indicates that it is to be deleted (*e.g., the message may be discarded; para.0073*).

**As to independent claim 16**, the rejection of independent claim 1 above is incorporated herein in full.

**As to dependent claim 17**, it includes the same limitations as in claim 2 above, and is similarly rejected under the same rationale.

**As to dependent claims 18-21**, they include the same limitations as in claims 7, 9, 11, and 13 above, and are similarly rejected under the same rationale.

**As to dependent claims 22-23**, they include the same limitations as in claims 14-15 above, and are similarly rejected under the same rationale.

**As to dependent claim 24**, Bose teaches transfer messages in the format using a HTTP protocol (*e.g., HTTP; para.0068*).

**As to dependent claim 25**, Bose teaches the HTTP protocol is HTTPS (*e.g., HTTPS; para.0068*).

**As to dependent claim 26**, Bose teaches the messages transferred using HTTP are in XML format (*e.g., XML data presentation format; para.0069 and 0092*).

**As to independent claim 27**, it includes the same subject matter as in claim 1 above, and is similarly rejected under the same rationale.

**As to dependent claim 28**, it includes the same limitations as in claim 2 above, and is similarly rejected under the same rationale.



**As to dependent claim 32**, Bose teaches retrieve messages stored on another server which were addressed to that other server, or a user account on that server, and to transmit retrieved messages to a client (*e.g., client...server; para. 0036 and 0069*).

**As to dependent claim 36**, Bose teaches a message store wherein the server is arranged to store messages for a client between sessions for that client (*e.g., client...server; para. 0036 and 0069*).

**As to dependent claim 37**, Bose teaches the server is arranged not to store messages for a client between sessions for that client (*e.g., discarding messages; para. 0073, 0080, and 0081*).

**As to dependent claims 38-40**, they include the same limitations as in claims 24-26 above, and are similarly rejected under the same rationale.

**As to dependent claim 41**, it includes the same limitations as in claim 11 above, and is similarly rejected under the same rationale.

**As to dependent claim 42**, Bose teaches the field indicating the action to be carried out on the message indicates that it is to be sent and the server is responsive to that field to send the message (*e.g., para. 0096-0098 shows that choice2 is selected by the user and the response will be sent to the poll initiator*).

**As to dependent claim 43**, Bose teaches the field indicating the action to be carried out on the message indicates that it is to be stored and the server is responsive to that field to store the message (*e.g., store messages; para. 0081*).

**As to dependent claim 44**, Bose teaches the field indicating the action to be carried out on the message indicates that it is to be deleted and the server is responsive to that field to delete the message (*e.g., the message may be discarded; para. 0073*).

**As to dependent claim 45**, Bose teaches a file defining which the delimited fields the message signal of the stored message should or may contain (*see para.0096 and 0097*).

**As to dependent claim 46**, Bose teaches interprets the message signal or stored messages using the file defining the fields (*see para.0099*).

**As to dependent claim 47**, Bose teaches the file defining the fields is in XML format (*e.g., the XML format; para.0092*).

**As to independent claim 48**, it includes the same subject matter as in claim 1 above, and is similarly rejected under the same rationale.

**As to dependent claim 49**, it includes the same limitations as in claim 2 above, and is similarly rejected under the same rationale.

**As to dependent claim 50**, Bose teaches a message store, wherein the client is arranged to store messages between sessions with a server (*e.g., client...server; para. 0036 and 0069*).

**As to dependent claim 51**, Bose teaches the client is arranged not to store messages between sessions with a server (*e.g., discarding messages; para.0073, 0080, and 0081*).

**As to dependent claims 52-54**, they include the same limitations as in claims 45-47 above, and are similarly rejected under the same rationale.

**As to dependent claims 55-57**, they include the same limitations as in claims 24-26 above, and are similarly rejected under the same rationale.

**As to dependent claim 58**, it includes the same limitations as in claim 11 above, and is similarly rejected under the same rationale.

**As to dependent claims 59-61**, they include the same limitations as in claims 42-44 above, and are similarly rejected under the same rationale.

**As to independent claim 62**, it includes the same subject matter as in claim 1 above, and is similarly rejected under the same rationale.

**As to independent claim 63**, it includes the same subject matter as in claim 1 above, and is similarly rejected under the same rationale.

**As to dependent claims 64-66**, they include the same limitations as in claims 24-26 above, and are similarly rejected under the same rationale.

**As to independent claim 67**, it includes the same subject matter as in claim 1 above, and is similarly rejected under the same rationale.

**As to dependent claim 68**, it includes the same limitations as in claim 2 above, and is similarly rejected under the same rationale.

8. Claims 29-31 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bose** in view of **Wang** (U.S. Patent Application Publication filed 07/19/2001, priority 07/20/2000).

**As to dependent claim 29**, Bose does not specially teach “convert message signals or stored messages in the format to another format and to transmit converted messages in the other format.”

Wang teaches convert message signals or stored messages in the format to another format and to transmit converted messages in the other format (*the XML message ... is translated into a WML message ... and sent to the WML server; para.1025*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Wang in the system of Bose because it would have

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provided the capability for increasing the flexibility of transmitting and receiving messages between different servers.

**As to dependent claim 30,** Bose does not specially teach “convert messages in another format to the format and to transmit converted messages in the format.”

Wang teaches convert messages in another format to the format and to transmit converted messages in the format (*e.g., para. 130 shows that WML message is translated into a WML message and sent to XML server*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Wang in the system of Bose because it would have provided the capability for increasing the flexibility of transmitting and receiving messages between different servers.

**As to dependent claim 31,** Bose does not specially teach “transmit the converted messages to a client.”

Wang teaches transmit the converted message to a client (*para. 0125 shows that XML message is translated into a WML message, and the XML message is sent to mobile device*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Wang in the system of Bose because it would have provided the capability for increasing the flexibility of transmitting and receiving messages between different servers.

**As to dependent claim 33,** Bose does not specially teach “convert messages in the format to a format including display layout in formation.”

Wang teaches convert messages in the format to a format including display layout in formation (*para.0125 – 0126*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Wang in the system of Bose because it would have provided the capability for increasing the flexibility of transmitting and receiving messages between different servers.

**As to dependent claim 34**, Bose teach the format is XML (*e.g., XML format; para.0092*), but does not specially teach “the server is arranged to perform the conversion to a format including display layout information using Extensible Stylesheet Language.”

Wang teaches the server is arranged to perform the conversion to a format including display layout information using Extensible Stylesheet Language (*The XML message ... is translated into a WML message including using XSL to translate style; para.0125 – 0131*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Wang in the system of Bose because it would have provided the capability for increasing the flexibility of transmitting and receiving messages between different servers.

**As to dependent claim 35**, Bose does not specially teach “the conversion is to Wireless Mark-up Language.”

Wang teaches the conversion is to Wireless Mark-up Language (*message is translated into a WML message; para.0125-0131*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Wang in the system of Bose because it would have

provided the capability for increasing the flexibility of transmitting and receiving messages between different servers.

### **Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Coelho et al. U.S. Patent No. 6,347,340 issued: Feb. 12, 2002

Brown et al. U.S. Patent Application Pub. 2002/0078158 issued: Jun. 20, 2002

Halahmi et al. U.S. Patent No. 6,684,088 issued: Jan. 27, 2004

Abjanic et al. U.S. Patent Application Pub. 2003/0069975 issued: Apr. 10, 2003

Hansen et al. U.S. Patent No. 6,757,714 issued: Jun. 29, 2004

Rohit Khare, "The Transfer Protocols", University of California, March-April 1998, pages 80-82.

Emmerich et al. "Implementing Incremental Code Migration with XML", ACM 2000, pages 397-406.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092. After mid-October, 2004, the examiner can be reached at (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

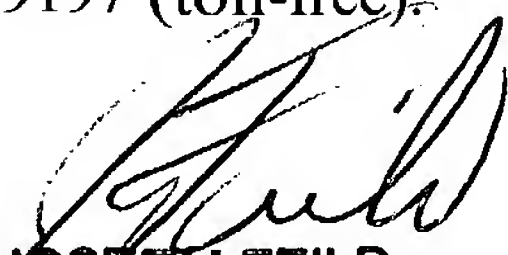
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (703) 305-9792.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maikhanh Nguyen  
October 1, 2004



JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER